

REMARKS

The official action of 13 April 2008 has been carefully considered and reconsideration of the application as amended is respectfully requested.

Claims 11 and 12 stand rejected under 35 USC 103(a) as allegedly being unpatentable over Sakamoto in view of Dimitrakopoulos. Applicants respectfully traverse this rejection.

Since Sakamoto is not a patent publication it is citable as prior art, if at all, as a “printed publication” under the provisions of 35 USC 102(a) or (b). However, in order to constitute a prior art reference as a “printed publication”, there must be proof that the reference was accessible to the public as of the effective filing date of the application. See MPEP 2128, citing *Carella v. Starlight Archery*, 804 F.2d 135, 231 USPQ 644 (Fed. Cir. 1986) (“The court held that since there was no proof that either the advertisement or mailer was accessible to any member of the public before the filing date there could be no rejection under 35 U.S.C. 102(a).”). In the present case, the effective filing date of the application is 18 February 2004, the date of Applicants’ Japanese priority application. (Note: Applicants have previously submitted an English translation of the Japanese priority application to perfect their claim to priority in accordance with the provisions of MPEP 201.15.)

In view of the above, for Sakamoto to be citable against the present application under 35 USC 103(a) via either 102(a) or (b), the Examiner must provide proof that the reference has a publication date earlier in time than the effective filing date of 18 February 2004. Applicants respectfully note that the Examiner has not even alleged this: the Examiner has alleged that the reference was published “February 2004” (see Form PTO-892 attached to official action). *A fortiori* the Examiner has not shown that the reference was accessible to the public prior to the effective filing date of the reference, 18 February 2004, and has thus not satisfied the USPTO burden of showing that the reference is citable as a “printed publication” under the provisions of 35 USC 102(a) or

(b) (see MPEP 2128). Accordingly, Applicants respectfully submit that the references cannot set forth even a *prima facie* case of obviousness against the invention as claimed and that the rejection based on Sakamoto as primary reference should be withdrawn for this reason alone.

Claim 13 was rejected under 35 USC 103(a) as allegedly being unpatentable over Suzuki in view of Bao. The rejection of claim 13 has been rendered moot by the cancellation of this claim.

Specifically, claim 13 has been canceled and replaced with new claims 17-18. Support for the recitations in the new claims can be found in the specification as filed at, for example, page 18, lines 1-8 and original claims 6 and 7.

The new claims are written in product-by-process format in accordance with the description in the specification as filed at, for example, page 7, line 32 to page 9, line 5 and page 8, lines 13-19, which teaches that the recited process for producing the claimed organic thin-film transistor results in the transistor having a higher carrier-mobility. Under these circumstances, the recited process steps should be considered in evaluating the patentability of the claimed product. See MPEP 2113 (“The structure implied by the process steps should be considered when assessing the patentability of product-by-process claims over the prior art, especially where. . . the manufacturing process steps would be expected to impart distinctive structural characteristics to the final product.”).

When the recited process steps are considered in assessing the rejection, it is clear that the cited references do not show or suggest the claimed product. Thus, neither of the cited references teaches or suggests at least the claimed feature of “the thin film of organic semiconductor layer is obtained by controlling temperature of the substrate to 30°C or higher and 65°C or lower and vacuum-depositing tetradeca-fluoropentacene (C₂₂F₁₄) on the substrate at 1 x 10⁻⁴ pascals or lower” as recited in claim 17 or at least the claimed feature of “the thin film of organic semiconductor layer is

obtained by controlling temperature of the substrate to 24°C or higher and 60°C or lower and vacuum-depositing dodecafluoronaphthacene ($C_{18}F_{12}$) on the substrate at 1×10^{-4} pascals or lower" as recited in claim 18.

In view of the above, Applicants respectfully submit that the cited references cannot set forth even a *prima facie* case of obviousness for the invention as claimed and that the rejection based on Suzuki and Bao should accordingly be withdrawn.

Accordingly, Applicants respectfully submit that all rejections and objections of record have been overcome and that the application is now in allowable form. An early notice of allowance is earnestly solicited and is believed to be fully warranted.

Respectfully submitted,

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